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Supreme Court of the United States

OCTOBER TERM, 1943.

No. 269

GEOPHYSICAL DEVELOPMENT CORPORATION, SHELLEY KRASNOW AND LEON F. CURTISS,
Petitioners,

v.

CONWAY P. COE, COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA, AND BRIEF IN SUPPORT THEREOF.

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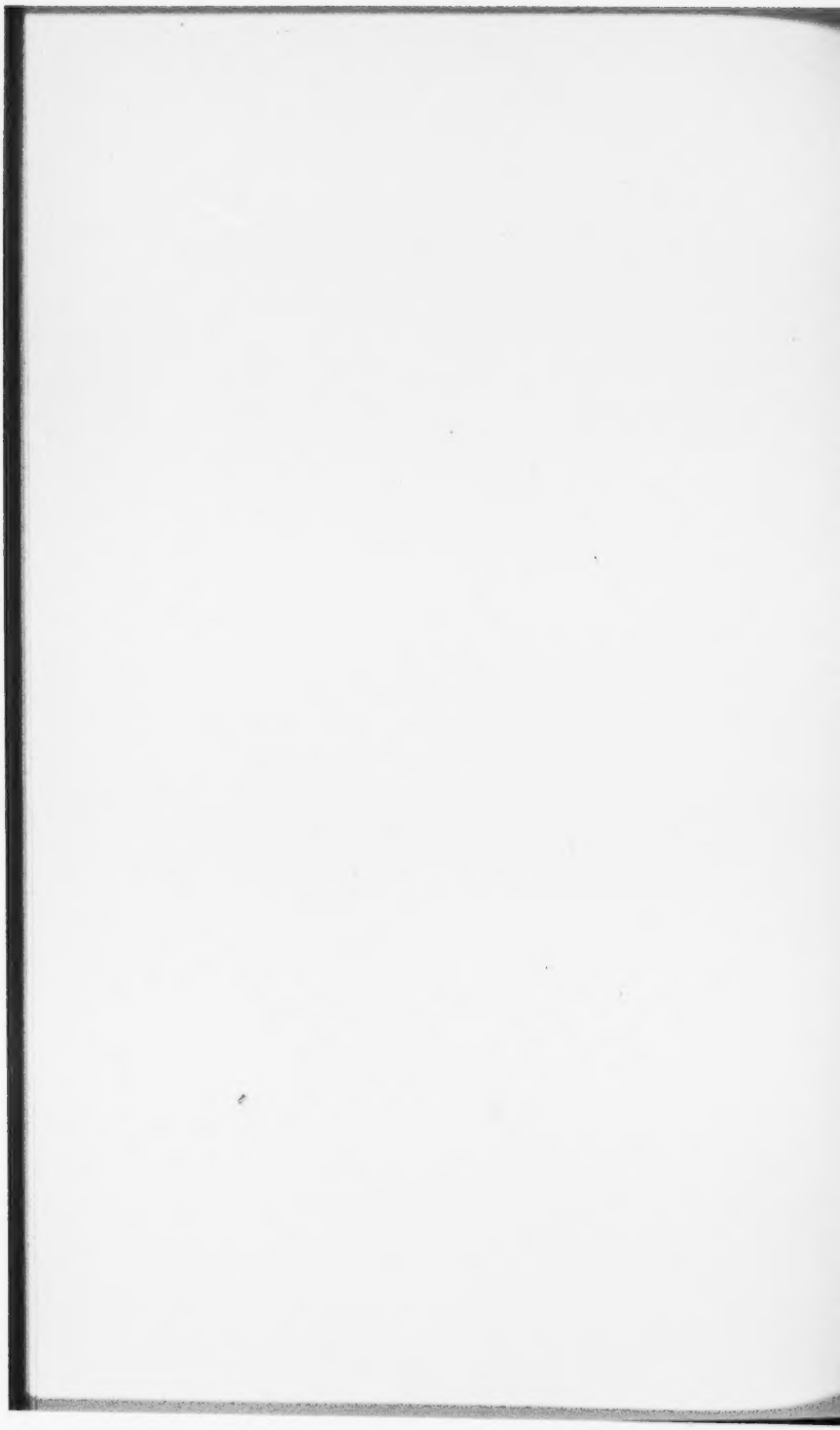

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA, AND BRIEF IN SUPPORT THEREOF.

May it please the Court:

The petition of Geophysical Development Corporation, Shelley Krasnow and Leon F. Curtiss respectfully shows to this Honorable Court:

A.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

The petitioners filed their complaint (R. 1-15), subsequently amended (R. 34-37), in the District Court of the United States for the District of Columbia against the respondent, as Commissioner of Patents, by which they sought an order

of that Court requiring the respondent to permit the taking of certain testimony and the filing of certain interrogatories in support of their motion, then and now pending, to dissolve an interference declared in a proceeding pending in the Patent Office.

On motion of the respondent (R. 37) the District Court dismissed the amended complaint (R. 38); the petitioners appealed to the United States Court of Appeals for the District of Columbia, which affirmed the judgment of the District Court (R. 40-42).

The facts, as averred by the complaint and the amendment thereto, and admitted by the motion to dismiss, are as follows:

There is pending in the Patent Office the application of petitioners Krasnow and Curtiss for letters patent on certain improvements in method and apparatus for measuring radio activity (R. 1). Petitioner Geophysical Development Corporation is their assignee (R. 1).

The respondent declared an interference in respect of certain of the claims of this application with a then pending application of one Neufeld and with a later filed application of one Howell (R. 2, 5).

Petitioners filed a motion to dissolve the interference, on the ground that the applications of Neufeld and Howell did not contain complete disclosures as required by R.S. 4888, 35 U. S. C. 33 (R. 6). The respondent granted this motion in part (R. 6).

In order to delay or prevent issuance of a patent to petitioners, and to put them to inordinate expense, Neufeld and Well Surveys, Inc., assignee of Neufeld, thereupon disclosed the issues in the interference to one Bender, to whom a patent on a different invention had previously issued, and to Lane-Wells Company, assignee of Bender, and induced Bender and Lane-Wells Company to file an application for reissue of the Bender patent to include the claims involved in the interference (R. 7); Bender and Lane-Wells Company thereupon filed an application for reissue of the Ben-

der patent, alleging in support thereof that the patent previously issued to Bender was inoperative because of the omission from the specification of certain claims corresponding with certain counts of the interference, and falsely alleging that the errors which rendered the patent inoperative arose from inadvertence, accident or mistake (R. 8-9). The reissue application was thereupon included in the interference (R. 11).

Petitioners moved in the Patent Office to dissolve the interference with respect to the Bender application, upon the ground that there was no inadvertence, accident or mistake to support the application for reissue of the Bender patent, and that there was no sufficient excuse for the delay of almost two years in applying for such reissue (R. 14, 19-22). At the same time, they moved that times be set for the taking of testimony in support of their motion and for leave to file interrogatories to be answered by officers of Well Surveys, Inc. and Lane-Wells Company, respectively (R. 14, 16, 22-28). It was stated in the motion to take testimony (R. 23-24) and the statement was verified by the affidavit of petitioner Krasnow (R. 28-29), that the testimony proposed to be taken was to the effect that prior to the issuance of the Bender patent, Krasnow had disclosed to Lane-Wells Company, assignee of Bender, the subject-matter of the petitioners' application and had given it a copy of his application and drawings thereof; that for some time thereafter Lane-Wells Company negotiated with Krasnow for the purchase of rights under his invention; and that there is an identity of interest between Bender and Neufeld and their respective assignees (R. 23-24, 28-20), although ostensibly adverse parties. The interrogatories proposed to be filed showed on their face that they were to elicit testimony as to the identity of interest above referred to (R. 17-18, 27-28).

The Examiner of Interferences dismissed the motion to dissolve, the motion to take testimony, and the motion to file interrogatories. The respondent reversed the action of

the Examiner of Interferences in dismissing the motion to dissolve, and held that the motion to dissolve afforded proper grounds for dissolution, "if established by the record"; however, he affirmed the action of the Examiner of Interferences in denying to the petitioners the right to present evidence in support of their motion, and in denying them the right to file interrogatories (R. 32-33).

Petitioners also aver in their pleadings in the District Court, and the respondent's motion to dismiss admits that:

The original Bender patent was not defective and insufficient but covers the invention intended to be patented therein and there was no inadvertence, accident or mistake in the grant thereof (R. 9);

Petitioners in December, 1937, disclosed the invention set forth in their application, to Bender and his assignee, Lane-Wells Company (R. 9);

During the prosecution of the original Bender patent, Bender and his assignee deliberately canceled claims broader than the interference issue (R. 10), with knowledge of the claim and application of petitioners (R. 12);

The interests of Neufeld and his assignee, Well Surveys, Inc., and of Bender and his assignee, Lane-Wells Company, in the issue of the interference, are identical, and they have at all times been represented by the same record attorneys (R. 11);

The questions raised on petitioners' motion for dissolution in the interference are questions of fact and require the production of evidence not of record in the United States Patent Office (R. 34);

The record in the Patent Office contains none of the evidence on which petitioners must rely to establish the facts in support of their motion for dissolution; they never have had an opportunity to present such evidence, since the Patent Office record was made prior to the questions being raised on the motion for dissolution; and such evidence will not become a part of the record unless petitioners are

permitted to introduce it in the form of affidavits, depositions or other evidence not otherwise of record (R. 35);

No evidence on the question of inadvertence, etc., raised on petitioners' motion to dissolve the interference, will be considered by the respondent after there has been a decision on those questions on the pending motion for dissolution; and petitioners' sole opportunity to have any such evidence considered on those questions is by placing such evidence of record before there is any decision on the motion for dissolution (R. 35-36).

B.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

1. The case presents an important question of procedure in the United States Patent Office.

2. The opinion and judgment of the United States Court of Appeals for the District of Columbia, sustaining the action of the respondent, sanctions a denial of due process of law to the petitioner, and

3. Is based on an incorrect and improper interpretation of the statutes and regulations relating to proceedings in the United States Patent Office.

WHEREFORE your petitioners respectfully pray that the writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the United States Court of Appeals for the District of Columbia, to certify and to send to this Court for its review and determination on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket No. 8209, Geophysical Development Corporation, Shelley Krasnow and Leon F. Curtiss, *Appellants* v. Conway P. Coe, Commissioner of Patents, *Appellee,* to the end that the said judgment of the

United States Court of Appeals for the District of Columbia be reviewed and determined by this Honorable Court; and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

LAWRENCE KOENIGSBERGER,
Counsel for Petitioners.

Supreme Court of the United States

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CONWAY P. COE, COMMISSIONER OF PATENTS,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

THE OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

The opinion of the United States Court of Appeals for the District of Columbia has not yet been reported. It was delivered June 7, 1943, and will be found on pages 40-42 of the Record. The docket number of this case in the United States Court of Appeals for the District of Columbia is 8209.

II.

JURISDICTION.

1. This Honorable Court has jurisdiction to grant the writ of certiorari here prayed for, by virtue of the provisions of section 240 (a) of the Judicial Code, as amended [28 U. S. C. Sec. 348 (a)], as follows:

> "In any case, civil or criminal, in a circuit court of appeals, or in the United States Court of Appeals for the District of Columbia, it shall be competent for the Supreme Court of the United States, upon the petition of any party thereto, whether Government or other litigant, to require by certiorari, either before or after a judgment or decree by such lower court, that the cause be certified to the Supreme Court for determination by it with the same power and authority, and with like effect, as if the cause had been brought there by unrestricted appeal."

2. This is a civil case in the United States Court of Appeals for the District of Columbia.

3. The following case is believed to sustain the jurisdiction of this Court: *Exhibit Supply Co.* v. *Ace Patents Corporation,* 315 U. S. 126.

III.

STATEMENT OF THE CASE.

A full statement of the case has been given under heading "A" of the Petition for Writ of Certiorari filed herewith and, in the interest of brevity, is not repeated here.

IV.

SPECIFICATION OF ERRORS.

The United States Court of Appeals for the District of Columbia erred:

1. In holding that it was no concern of petitioners, parties to an interference, whether Bender, another party to

the interference, who had been made such by reason of the pendency of his reissue application, had forfeited his right to a reissue.

2. In holding that Bender's good faith in applying for reissue of his patent is secondary to the determination of priority, notwithstanding the statutory requirement that application for reissue must be supported by oath that the defect or insufficiency of the patent arose from "inadvertence, accident or mistake without any fraudulent or deceptive intention."

3. In holding that whether Bender had forfeited his right to a reissue is a question the Patent Office may properly deal with "in its own good time," notwithstanding respondent, as Commissioner of Patents, had held the question of forfeiture was properly raised by petitioners on motion to dissolve; thus in effect holding that an interference may be declared with a reservation of the question of patentability to one of the parties reserved for future adjudication.

4. In holding that the decisions cited by it held that parties to an interference had no right to raise questions on motion to dissolve which were not ancillary to priority.

5. In holding that the Commissioner of Patents, after having decided that petitioners had a right to be heard on the question of whether Bender had forfeited his right to a reissue, had the right to restrict petitioners to such evidence in support of their contention as was already of record in the Patent Office.

6. In holding that, although the public interest might well be served by the admission of testimony in support of petitioners' contention, it nevertheless should refuse to interfere with the action of the Commissioner in excluding such testimony.

7. In holding that in the cases cited on behalf of petitioners, the motions to dissolve were on grounds held to be ancillary to the question of priority.

V.

THE QUESTION INVOLVED.

The question involved is:

Where an interference is pending in the Patent Office and one of the parties to the interference, pursuant to regulations of the Patent Office, has filed a motion to dissolve the interference upon grounds not a matter of record in the Patent Office, and the Commissioner of Patents has held that the motion to dissolve the interference will lie, may the Commissioner refuse to permit the parties so moving to introduce evidence not appearing of record, by means of interrogatories or depositions?

VI.

SUMMARY OF THE ARGUMENT.

The refusal of the Commissioner of Patents to permit petitioners to introduce evidence in support of their motion for dissolution, after the Commissioner of Patents had held it presented proper questions to be determined in the interference, is contrary to law because (a) it is based on an incorrect interpretation of the statute and regulation and (b) it is a denial of due process of law.

VII.

ARGUMENT.

An interference is a proceeding instituted under the provisions of R. S. 4904, 35 U. S. C. 52, for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention.

The Commissioner of Patents, under R. S. 481, 483, 35 U. S. C. 6, has established Rule 122, Rules of Practice in the United States Patent Office, the material portions of which are as follows:

"122. Motions to dissolve an interference * * * (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, * * * should contain a full statement of the grounds relied upon * * *. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. * * *".

It is thus apparent that a motion to dissolve an interference and a hearing thereon, is a recognized and authorized mode of procedure in the Patent Office, and among the grounds upon which such a motion may be based is the denial of the patentability of an applicant's claims and the right of an applicant to make the claims. The purpose of Rule 122, is to test the propriety of the declaration of the interference. If the issue involved in the interference is unpatentable, or one of the parties has no right to make the claim, or the claim is unpatentable to one of the parties, or if the issue is not supported by a party's case, these and similar questions go to the propriety of the declaration of the interference and lie at the threshold thereof. Rule 95 provides that before an interference is declared it must be determined by the Patent Office that there is common patentable subject matter in the case of the respective parties. Rule 122 provides for a determination of these questions prior to any further proceedings in the interference.

Two distinct types of questions arise on motion for dissolution of an interference. They are distinguished by whether they are or are not ancillary to priority. The term "ancillary" is used in such cases in the sense of "subordinate" or "auxiliary" to the question of priority.

(a) If ancillary to priority they will be considered at all later stages of the interference including court proceedings reviewing the question of priority.

Podlesak v. *McInnerney*, 26 App. D. C. 399.

Such questions as are ancillary include sufficiency of disclosure to make the claim, and operativeness of the disclosed invention.

(b) If not ancillary to priority they will be considered on motion for dissolution but will not be considered at any later stage of the interference, or in any court proceedings reviewing the question of priority.

Ellis v. *Maddox,* 96 F. (2d) 308;
Ackerman v. *Light,* 96 F. (2d) 304;
Norling v. *Hayes,* 37 App. D. C. 160;
Earles v. *Gomber,* 50 App. D. C. 389, 273 F. 353;
Bechtold v. *Lanser,* 82 F. 415.

Such non-ancillary questions include inadvertence, accident and mistake in support of reissue and many other statutory bars to a reissue patent.

In the interference proceeding in the Patent Office, petitioners moved to dissolve the interference with respect to the Bender reissue application upon the ground that there was no inadvertence, accident or mistake to support the application for reissue of the Bender patent, as required by R. S. 4916, 35 U. S. C. 64, *infra,* p. 21. Such matters have repeatedly been held to bar any valid reissue.

Union Switch & Signal Co. v. *Louisville Signal Co.,* 73 F. (2d) 550, 551, (C. C. A. 6);
Application of White, 57 App. D. C. 355, 23 F. (2d) 776.

If Bender has no properly filed reissue application, he has no right to contest priority in this interference, and this question must be considered at the very beginning of the interference. As said by the Court of Appeals of the District of Columbia in *Oliver* v. *Felbel,* 20 App. D. C. 255, 259:

> "We understand the rules and the practice of the Patent Office to be in accordance with this requirement of law and right reason; and that no interference is ever declared between parties until there has been an adjudication of patentability. The absurdity of a

> declaration of interference, with a reservation at the same time of the question of patentability for future adjudication, would be, so far at least as this court is concerned, too glaring to be tolerated."

That these questions may be specifically considered and determined on motion for dissolution has long been settled. In the case of *Latta and Thompson* v. *Murphy,* 1915 C. D. 7, 8, the Commissioner said:

> "In order to be entitled to a reissue, the applicant must show that the failure to make the claims arose through inadvertence, accident, or mistake, and if there was delay in filing the application he must give a satisfactory explanation thereof. If the oath in this case is not sufficient, the reissue application should not have been held allowable by the Examiner, and the reissue applicants have no right to contest the interference."

The question raised by petitioners' motion to dissolve, which they seek to sustain by testimony, is not Bender's right to a patent, but Bender's qualification as an opponent to contest with them the issue of priority. The fact that the reasons which show that Bender is not a properly qualified opponent may also be grounds for denying him a patent in later proceedings, is no reason for respondent's refusal to consider them at the present stage.

In the case at bar, the respondent held that petitioners were entitled to a hearing on the grounds raised in the motion to dissolve, saying in that connection, in his order of June 30, 1940 (R. 32):

> "The motion to dissolve alleges that the counts are unpatentable in Bender's reissue application because the failure to include them in his patent was not due to inadvertence, accident or mistake, and because an election not to prosecute the counts in the Bender application has been made. These contentions, if they can be established from the record, afford proper grounds for dissolution and, in view of the authorities cited by the petitioner, this motion should have been set for hearing."

Thus the respondent has determined that there should be a hearing on the issues of inadvertence, accident or mistake in the Bender reissue application and of the election not to prosecute, and has ordered a hearing on those questions.

But in refusing petitioners the right to introduce evidence in support of that motion for dissolution, he is acting arbitrarily and is denying to petitioners due process of law.

The motion to dismiss admits that the questions raised on petitioners' motion for dissolution are questions of fact and require the production of evidence not of record in the United States Patent Office (R. 34), and that the record to which respondent restricts the consideration, contains none of the evidence on which petitioners must rely to establish the facts in support of their motion for dissolution; that petitioners have never had an opportunity to present such evidence (R. 35); that no evidence on the question of inadvertence, accident or mistake, or fraud, will be considered by respondent after there has been a decision of those questions on the pending motion for dissolution; and that petitioners' sole opportunity to have any evidence considered on these questions is by placing such evidence of record before there is any determination of the motion for dissolution (R. 35).

Thus, the respondent accepts the *ex parte* affidavit filed on behalf of Bender in support of his reissue application as conclusive; and denies petitioners opportunity to present evidence in the form of affidavits, depositions or otherwise, to contradict it.

This is clearly discrimination against petitioners. As stated in *Baltimore and Ohio Railroad Co. v. United States,* 298 U. S. 349 368:

> "The due process assures a full hearing before the court or other tribunal empowered to perform the judicial function involved. That includes the right to introduce evidence and have judicial findings based upon it."

Again in *Baltimore and Ohio Railroad Company* v. *United States,* 264 U. S. 258, 265:

> "* * * The provision for a hearing implies both the privilege of introducing evidence and the duty of deciding in accordance with it. To refuse to consider evidence introduced, or to make an essential finding without supporting evidence, is arbitrary action."

Again in *Interstate Commerce Com.* v. *L. & N. R. Co.,* 227 U. S. 88, 93:

> "* * * manifestly there is no hearing when the party does not know what evidence is offered or considered, and is not given an opportunity to test, explain or refute."

Mandamus will lie to compel a court to grant a hearing or to hear evidence. In *McCullough* v. *Cosgrave,* 309 U. S. 634, 3 Fed. Rules Serv. 496, which was a patent-infringement case, the District Court had assigned the case to a Master for trial, upon the ground that the Judge was unable to try the case because of his physical condition, that the issues were complicated, the calendar congested, and no other Judge was available to try the case within a reasonable time. Application was made to this Court for leave to file a petition for mandamus to compel the Judge to hear the case. This Court directed the District Judge to vacate the order of reference and to try the case in the regular way. Thus this Court saw fit to control by mandamus the question of whether a case should or should not be referred to a Master under F. R. C. P. 53(b).

Questions of inadvertence, accident or mistake, which are not ancillary to priority, will not be considered in any court proceeding under R. S. 4911, 35 U. S. C. 59a to review a decision on priority. In each of the following cases, after decision on priority, a statutory bar was urged against the reissue applicant, but was refused consideration by the Court:

Ellis v. *Maddox,* 96 F. (2d) 308;
Ackerman v. *Light,* 96 F. (2d) 304;
Daley v. *Trube,* 88 F. (2d) 308.

These decisions establish conclusively, and we know of no decisions contrary thereto, that after there has been a decision in the Patent Office on motion for dissolution, questions not ancillary to priority, in a reissue application, will not be considered. They will be considered in the Patent Office on motion for dissolution only. Therefore unless petitioners are given the right to introduce evidence in support of their motion for dissolution, which raises questions which are not ancillary to priority and may be considered only on motion for dissolution, they cannot raise those questions at a later time.

The fact that respondent will not consider those questions at any later time in the interference, is sufficient ground for the relief sought in the present proceedings.

Even in a proceeding under R.S. 4915, 35 U. S. C. 63, instituted upon an adverse decision on priority, the court will not consider any question except priority, *Ewing* v. *United States ex rel. Fowler Car Co.,* 244 U. S. 1, 11, and such matters as would bar a patent to the plaintiff in such action, *Radtke Patents Corporation* v. *Coe,* 122 F. (2d) 937. In such an action, where the right of the defendant is based on a reissue application, the court will not consider any question which goes to the right of the defendant to a reissue, such as inadvertence, accident or mistake, because in such case the right of the defendant to a patent is not involved.

Respondent should not be permitted successfully to defend his position by contentions of expediency. The evidence which plaintiffs seek to introduce is not extensive and will not result in any delay. The questions raised are simple. In any event, contentions of expediency can in no case justify a denial of due process. As stated by this Court in *Ohio Bell Telephone Co.* v. *Public Utilities Commission,* 301 U. S. 292, 305:

> "There can be no compromise on the footing of convenience or expediency, or because of a natural desire to be rid of harrassing delay, when this minimal requirement [due process] has been neglected or ignored."

As the Commissioner of Patents said in *Kinsman* v. *Strohm*, 1906 C. D. 481, 483:

> "The question of delay is the only serious one presented by this appeal, and in view of all the circumstances it is believed that this question should be resolved to permit the evidence to be produced. If the truth in this matter is hurtful to Strohm, it should not be suppressed. In such event he is in no position to urge that it should not be used against him. If it is not hurtful to his case, he can only be injured by the delay and expense incident to taking additional testimony. The record of Strohm's application offsets any objection he might urge on the ground of delay. As the proposed testimony is limited to a single restricted subject of inquiry, the expenses in connection therewith will probably be comparatively small. However that may be, the objection of expense alone is not sufficient to offset the reasons for admitting the proposed testimony notwithstanding the delay which occurred."

The Court of Appeals misconceived the issues in the case when it said in the course of its opinion (R. 41) that respondent held that "it is of no concern to appellants [petitioners] whether Bender in his original application deliberately cancelled his claims and thereby forfeited his rights, for that is a question the [Patent] Office will deal with in its own good time, and the decision of which will neither help nor hurt appellants." The respondent has not held that the question of Bender's right to a reissue is of no concern to petitioners. On the contrary he has expressly held that it is a matter of concern to petitioners, and has set down for hearing their motion to dissolve the interference on that ground. The grievance of which petitioners complain is not that the respondent has refused to let them

be heard on Bender's right to a reissue, but that, having decided that they have a right to be heard, he has so circumscribed the hearing by restricting it to matters of record, as to amount to a denial in fact of a right to which he has held them to be entitled. Indeed, the Court of Appeals quite properly held that from many points of view public interest might well be served if the Patent Office admitted testimony in an interference proceeding as to the bad faith of the applicant for reissue (R. 41), but apparently considered itself powerless to bring about that result.

It is also respectfully submitted that the Court of Appeals fell into error when it cited *Ellis* v. *Maddox,* 96 F. (2d) 208 and other cases, in support of the statement that a party to an interference has not the right, on motion to dissolve, to be heard on the question of the right of another party to make a claim (R. 41). These will be found, upon examination, to have been cases in which questions not ancillary to priority (a) were in fact considered in the Patent Office on motion to dissolve the interference, but (b) it was held that such questions could not properly be considered on appeal from a decision on priority. The cases thus sustain petitioners' contention that if they are not permitted in the Patent Office to adduce evidence in support of their contention that Bender is not entitled to a reissue, they will not ever have an opportunity of doing so.

Motions for dissolution of interferences under Rule 122 are frequently based on affidavits or testimony both on matters ancillary to priority, as well as matters not ancillary to priority.

Thus in many situations where operativeness of an opponent's device is attacked on motion for dissolution, affidavits are submitted in support thereof. *Barney* v. *Hess,* 1910 C. D. 162; *Lowry and Cowley* v. *Spoon,* 1906 C. D. 224.

In *Gehring* v. *Barry et al.,* 1916 C. D. 16, the Commissioner of Patents held that it was proper on motion for dissolution for a party to make such motion accompanied by a showing of facts for leave to take testimony to establish abandonment of the invention.

In *Roller* v. *Goodwin,* 282 O. G. 387, 1921 C. D. 11, on a motion to dissolve on the ground of non-patentability of the issue in view of a foreign patent, it was held that affidavits to show inoperativeness of the device disclosed therein are competent.

Petitioners are not seeking to compel respondent to order a hearing on their motion to dissolve the interference; such hearing has already been ordered. The question is: where a hearing has been ordered on a motion to dissolve an interference, is the Commissioner required to permit the introduction of all relevant evidence, or may he arbitrarily confine the evidence to matters already of record in the Patent Office,—a record which was made up before the questions were raised on the motion for dissolution?

The refusal of respondent to permit petitioners to offer evidence in support of their motion for dissolution is arbitrary. Respondent's action accepts an *ex parte* affidavit of an opponent as conclusive on a question of fact and denies petitioners the right to submit relevant and material evidence to contradict that *ex parte* affidavit. No consideration of expediency can justify a denial of due process. The practice is manifestly unfair and a violation of the fundamental rights that should be accorded petitioners.

VIII.

CONCLUSION.

It is, therefore, respectfully submitted that this case is one calling for the exercise by this Court of its supervisory powers in order that the decision of the United States Court of Appeals for the District of Columbia be reversed and that to such an end a writ of certiorari should be granted and this Court should review the decision of the United States Court of Appeals for the District of Columbia and finally reverse it.

LAWRENCE KOENIGSBERGER,
Counsel for Petitioners,

APPENDIX.

Statutes.

52. Interferences; determination of priority; issue of patent.

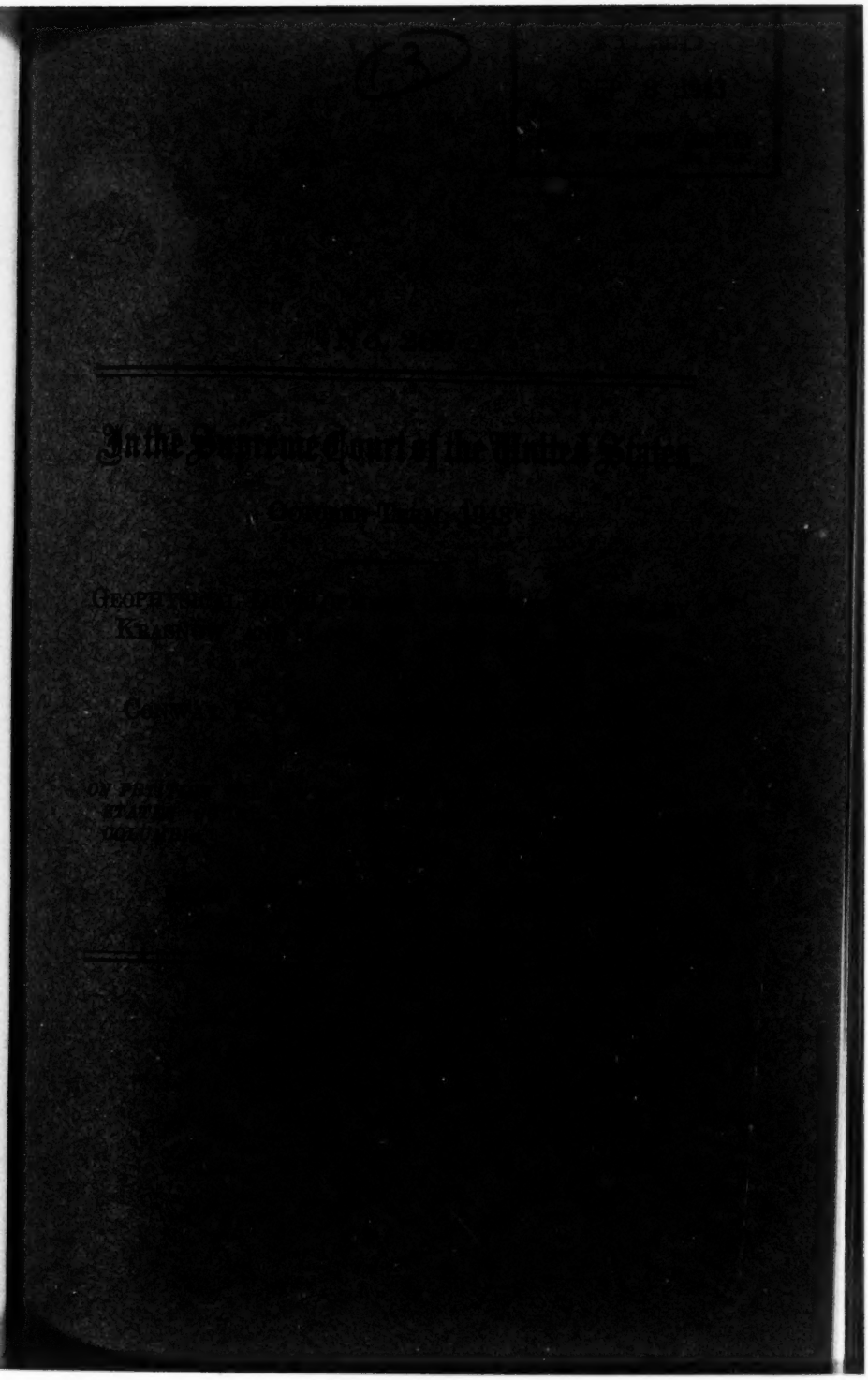
Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.

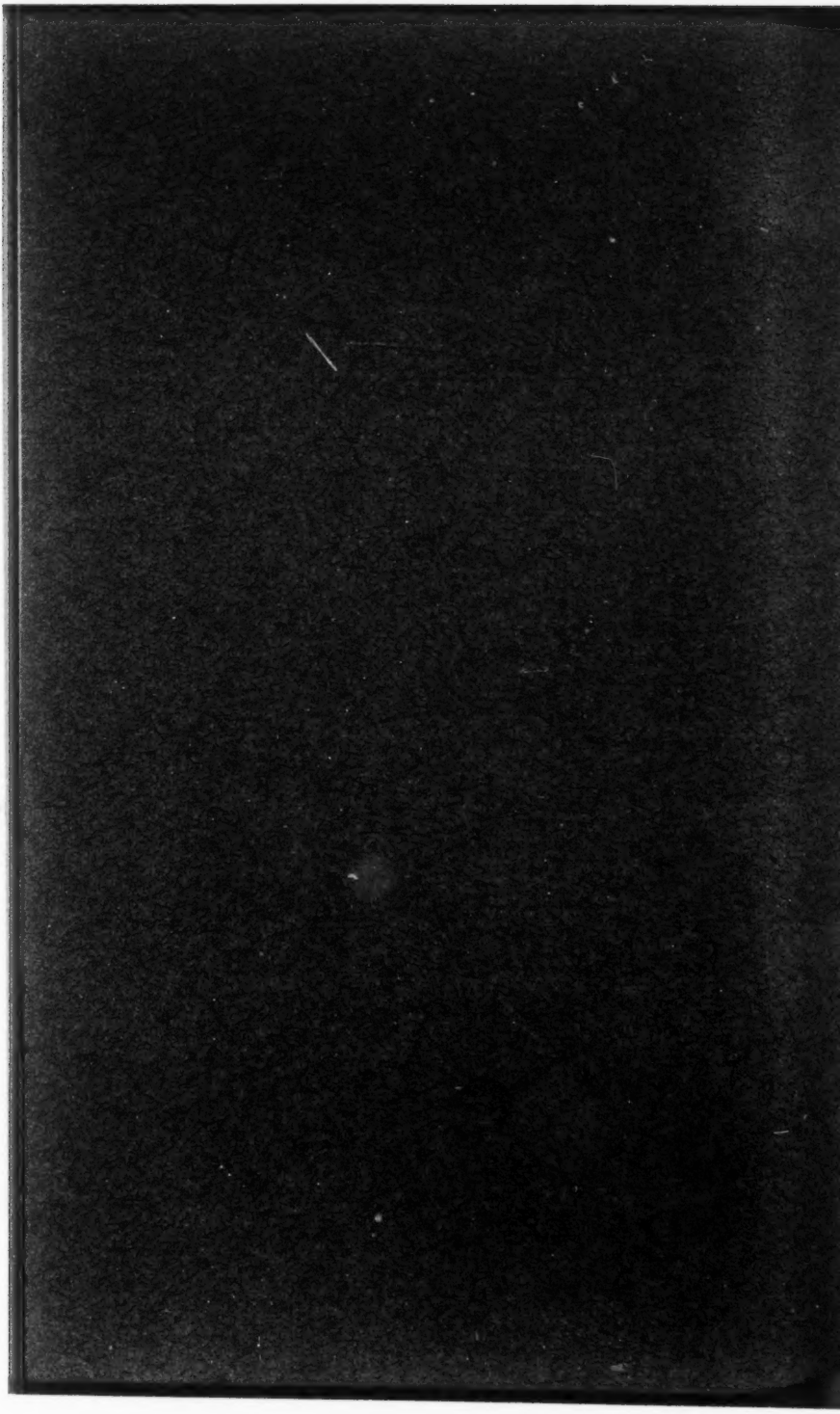
R. S. 4904, 35 U. S. C. 52.

64. Reissue of defective patents; patents for separate parts.

Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, andf in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. * * *

R. S. 4916, 35 U. S. C. 64.





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In the Supreme Court of the United States

OCTOBER TERM, 1943

No. 269

GEOPHYSICAL DEVELOPMENT CORPORATION, SHELLEY KRASNOW AND LEON F. CURTISS, PETITIONERS,

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The order of the District Court of the United States for the District of Columbia dismissing the original complaint (R. 33) and its order and opinion dismissing the amended complaint (R. 37–38) are not yet officially reported. The opinion of the United States Court of Appeals for the District of Columbia (R. 40–42) is not yet officially reported, but may be found in 58 U. S. P. Q. 50.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered June 7, 1943 (R. 43). The petition for writ of certiorari was filed August 17, 1943. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended.

QUESTION PRESENTED

Whether in an interference proceeding instituted pursuant to Rev. Stat. § 4904 (35 U. S. C. § 52) the Commissioner of Patents can be required by mandatory injunction to permit a party to adduce evidence not already in the records of the Patent Office, in support of a preliminary motion under Patent Office Rule 122 to dissolve the interference as to one of the parties thereto on an issue not related to priority.

STATUTES INVOLVED

The applicable provisions of Sections 481, 483 and 4904 of the Revised Statutes (35 U. S. C. §§ 6, 52) are set forth in the Appendix, pp. 13–14, *infra.*

STATEMENT

The pertinent facts, about which there is no dispute, are as follows.[1] Petitioners Krasnow & Cur-

[1] These facts were alleged by petitioners in their amended complaint in the District Court of the United States for the District of Columbia (R. 1–15), which defendant moved to dismiss (R. 37).

tiss[2] filed an application in the United States Patent Office for a patent on a device for measuring radio activity. This application was placed in interference proceedings in the Patent Office with the then pending application of one Neufeld, to which interference subsequently was added the later application of one Howell. (R. 1–5.) While the interference proceedings were pending, a patentee, Bender, applied under Rev. Stat. § 4916; 35 U. S. C. § 64 (App. p. 14, *infra*) for the reissue of his patent and included therein claims which were the same as those involved in the interference proceeding, alleging that these had been omitted from his original application as a result of inadvertence, accident, or mistake (R. 7–9). The Patent Office then added the Bender reissue application to the interference and at the same time declared another interference proceeding covering two of the eight counts in question, between the applications of Krasnow & Curtiss, Neufeld, and Bender (R. 10–11).[3] Thereupon petitioners moved in the Patent Office to dissolve the interferences as to Bender, alleging that Bender was not entitled to

[2] Petitioner Geophysical Development Corporation is the assignee of Krasnow and Curtiss, and first appeared in the proceedings in the District Court.

[3] An earlier motion by Krasnow & Curtiss to dissolve the first interference proceedings as to Howell was granted by the Patent Office as to counts 4 and 5 (R. 6–7), which were therefore stricken from the original interference and included in the separate interference proceeding to which all but Howell were parties (R. 10–11).

a reissue patent for the reasons that his failure to include in his earlier application the claims involved in the interference was not due to inadvertence, accident, or mistake, that there was inexcusable delay in filing the reissue application, and that Bender had deliberately cancelled from his earlier application the claims now in interference, thereby forfeiting his right to them. Petitioners simultaneously moved for leave to file interrogatories to be answered by Neufeld, Bender and their assignees, and for leave to present testimony in support of their motion. (R. 14, 16–31.) The Assistant Commissioner of Patents ordered that the motion to dissolve as to Bender be set for hearing, but denied the motion for interrogatories and testimony, ordering that the motion to dissolve be considered on the record in the Patent Office, in accordance with its long-established practice (R. 14–15, 32–33).

Thereupon, before the hearing could be held, petitioners sought a mandatory injunction in the District Court, to compel the Commissioner of Patents to permit the filing of interrogatories and the taking of testimony in support of the motion to dissolve (R. 15). The District Court granted the Commissioner's motion to dismiss petitioners' amended complaint (R. 33, 37, 38). The Court of Appeals in a *per curiam* opinion (R. 40–42) affirmed the dismissal (R. 43), on the grounds that the procedure prescribed for disposing of such

preliminary matters in interference proceedings was within the discretion of the Commissioner and "the action of the Commissioner * * * in following the long established practice and refusing to examine this question except on the records in his own office was * * * neither arbitrary nor unreasonable" (R. 42).

ARGUMENT

The statutory provision under which the present interferences were declared by the Commissioner of Patents authorizes him to "direct the primary examiner to proceed to determine the question of priority of invention" whenever a patent application, in his opinion, "would interfere with any pending application, or with any unexpired patent"; and a patent may be issued "to the party who is adjudged the prior inventor" (Rev. Stat. § 4904; 35 U. S. C. § 52).[4] As petitioners properly concede (Pet. 10), the sole *statutory* duty imposed upon the Patent Office in an interference proceeding is to determine prior-

[4] After the first interference here in question was declared on July 13, 1939, this section was amended by the Act of August 5, 1939 (53 Stat. 1212), to substitute a board of three examiners for the primary examiner. Under Section 5 of the amendatory act, the present interference proceedings will be governed by the statute as drawn prior to the amendment (the rearrangement of parties and issues in the second interference being "a mere matter of procedure," *New Departure Mfg. Co.* v. *Robinson*, 39 App. D. C. 504, 508); however, the substance of the statute so far as pertinent to the issue here presented was unchanged by the amendment.

ity of invention between the parties. *Allen* v. *United States ex rel. Lowry,* 26 App. D. C. 8, affirmed, 203 U. S. 476; *Ellis* v. *Maddox,* 90 F. (2d) 308 (C. C. P. A.).

Petitioners base their attack on the judgment below solely upon Rule 122 of the Rules of Practice in the United States Patent Office (37 Code Fed. Reg. § 1.122),[5] issued by the Commissioner under his discretionary authority to "establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office" (Rev. Stat. §§ 481, 483; 35 U. S. C. § 6). That Rule permits the filing of motions "in proper form" to dissolve an interference on certain grounds, including unpatentability of an applicant's claim or his want of right to make that claim.

1. Petitioners argue that having ordered a hearing on their motion to dissolve as to Bender, the Commissioner cannot validly refuse them the right to introduce supporting testimony (Pet. 13–14). But the hearing, which was ordered

[5] "122. Motions to dissolve an interference (a) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (b) denying the patentability of an applicant's claim, or (c) denying his right to make the claim, * * * should contain a full statement of the grounds relied upon * * *. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. * * *"

under Rule 122, was specifically limited to the record in the Patent Office (R. 32), and the consistent practice of the Patent Office under that Rule since its promulgation several decades ago has been to dispose of such preliminary motions solely on the records of the Patent Office.[6] *McKenzie* v. *Gillespie,* 93 O. G. 2103, 1900 C. D. 188; *Barratt* v. *Swinglehurst,* 144 O. G. 818, 1909 C. D. 121; *Horton* v. *Leonard,* 155 O. G. 305, 1910 C. D. 81; *Dunn* v. *Douglass,* 184 O. G. 804, 1912 C. D. 360; *Schuler* v. *Barnes* v. *Swartwout,* 140 O. G. 509, 1909 C. D. 42; *Sullivan* v. *Thomson,* 94 O. G. 585, 1901 C. D. 21; *Latham* v. *Force,* 82 O. G. 185, 1898 C. D. 1; *Felbel* v. *Oliver,* 92 O. G. 2339, 1900 C. D. 150; *Winton* v. *Jeffery,* 112 O. G. 500, 1904 C. D. 386; *Percy* v. *Martin,* 328 O. G. 530, 1924 C. D. 94.

[6] If the grounds for the motion relate directly to the question of priority, they may of course be considered at the full hearing upon that question. This explains three of the five Patent Office cases erroneously cited by petitioners (Pet. 17–19) in support of their contention that motions for dissolution under Rule 122, for reasons such as here advanced, may be based upon affidavits or testimony. The motions in *Barney* v. *Hess,* 1910 C. D. 162, and *Lowry and Cowley* v. *Spoon,* 1906 C. D. 224, involved the operativeness of the opponent's disclosure: priority can obviously be awarded only at the earliest operative disclosure. The motion in *Kinsman* v. *Strohm,* 1906 C. D. 481, involved the abandonment of an application relied upon to establish a record date of invention; and the Commissioner theretofore properly held this question was "pertinent to the question of invention." The other two cases cited by petitioner are not in point.

This consistent interpretation of the rule by the agency which promulgated it and which is charged with its administration constitutes persuasive authority as to its proper meaning. *Brewster* v. *Gage,* 280 U. S. 327, 336; *Allen* v. *United States ex rel. Lowry,* 26 App. D. C. 8 affirmed, 203 U. S. 476. Indeed such practice becomes an integral part of the rule by virtue of the power of the agency "to interpret its own rules and any phrase contained in them." See *Norwegian Nitrogen Products Co.* v. *United States,* 288 U. S. 294, 325. The rule, read in the light of its long-established administrative application, is an exercise of a discretionary power vested by Congress in the Commissioner, and as such beyond judicial control by injunction or mandamus. *Svenson* v. *Coe,* 69 App. D. C. 359; *United States ex rel. American Gas-Accumulator Co.* v. *Coe,* 84 F. (2d) 398 (App. D. C.); *Armstrong* v. *Levy,* 29 F. (2d) 953 (App. D. C.); *cf. Federal Communications Commission* v. *Pottsville Broadcasting Co.,* 309 U. S. 134, 143. In the absence of any statute clearly imposing upon the Commissioner a duty to afford petitioners the type of hearing they seek, there is no ground for interference by mandatory injunction with the exercise of his discretionary and quasi-judicial powers to regulate and order the proceedings upon interferences. *Cf. Federal Communications Commission* v. *Pottsville Broadcasting Co.,* 309 U. S. 134, 143.

2. Petitioners contend that the refusal to receive testimony is arbitrary and unconstitutional because the question of Bender's right to the reissue cannot be considered upon judicial review of the determination of priority. *Ellis* v. *Maddox,* 96 F. (2d) 308 (C. C. P. A.); *Earles* v. *Gomber,* 273 Fed. 353 (App. D. C.). But the non-reviewability of that question results from the fact that it is introduced in the interference not because of any requirement of law, but solely for the convenience of the Patent Office proceedings. The parties to an interference have no right under the statute to be heard at all on any question but priority (*Marx* v. *Brown,* 57 App. D. C. 177; *Ellis* v. *Maddox,* 96 F. (2d) 308, 311 (C. C. P. A.)); the Commissioner could properly have refused to provide for consideration of any preliminary motions and required parties to proceed to an immediate determination of priority (*Allen* v. *United States ex rel. Lowry, supra*). To the limited extent to which the Commissioner has provided for preliminary motions by Rule 122, he has in effect granted a favor to interference parties not required by any rule of law, thus enabling them to eliminate an opponent at the outset, if possible upon the Patent Office record.

Indeed, petitioners will suffer no deprivation of legal rights if the Commissioner should ultimately refuse to dismiss Bender from the proceeding.

If petitioners establish that they are the first inventors, they will be entitled to a patent whether or not Bender remains in the case. If Bender's proofs establish his priority, however, petitioners will have no right to a patent, whether or not Bender's claim to a patent is barred for other reasons. *Marx* v. *Brown,* 57 App. D. C. 177.

3. Petitioner's request for injunctive relief is premature and without equity. Their motion has been set for hearing upon the record in the Patent Office, and may well be granted.[7] Moreover, even if their motion is denied, petitioners may prove on the main proceeding that they are entitled to priority over Bender. The possibility of an ultimate outcome favorable to petitioners renders premature their complaint that they have been injured by the limitation of the hearing to voluminous matter already of record, for the requirement that they go to hearing upon the merits of the interference does not constitute such irreparable injury as will sustain equitable relief. *Cf. Myers* v. *Bethlehem Shipbuilding Corp.,* 303 U. S. 41, 50–51.

Moreover, the result reached below is justified by weighing public interest against petitioners'

[7] The Patent Office record should enable at least one of petitioner's major contentions to be fully considered: whether Bender cancelled from his earlier application claims substantially the same as those in interference. See R. 20–22, 34.

interest in easing their burden of proving priority by exclusion of Bender from the interferences at the present stage of the proceeding. Assuming that the testimony which petitioners have been denied the right to adduce will be determinative of whether Bender remains a party to the interferences, exclusion of the testimony might lead to proof establishing Bender's priority. But if, as petitioners allege, he has lost his rights to a reissued patent, the unclaimed invention, already disclosed in Bender's original patent, would thereby be placed in the public domain. *Phelan* v. *Green,* 71 F. (2d) 298 (C. C. P. A.); *Bechtold* v. *Lanser,* 82 F. (2d) 415, 419 (C. C. P. A.); *cf. Te Pas* v. *Geldhof,* 112 F. (2d) 800 (C. C. P. A.). On the other hand, admission of the testimony and the consequent exclusion of Bender from the interferences might result in the issuance to petitioners of a patent actually invalid for anticipation by Bender, but which, until a judicial declaration of invalidity, would constitute a cloud on the right of the public to utilize an invention already in its domain.

CONCLUSION

The case was correctly decided below. No important or novel question of law is involved, and there is no conflict of decisions. We therefore

respectfully submit that the petition should be denied.

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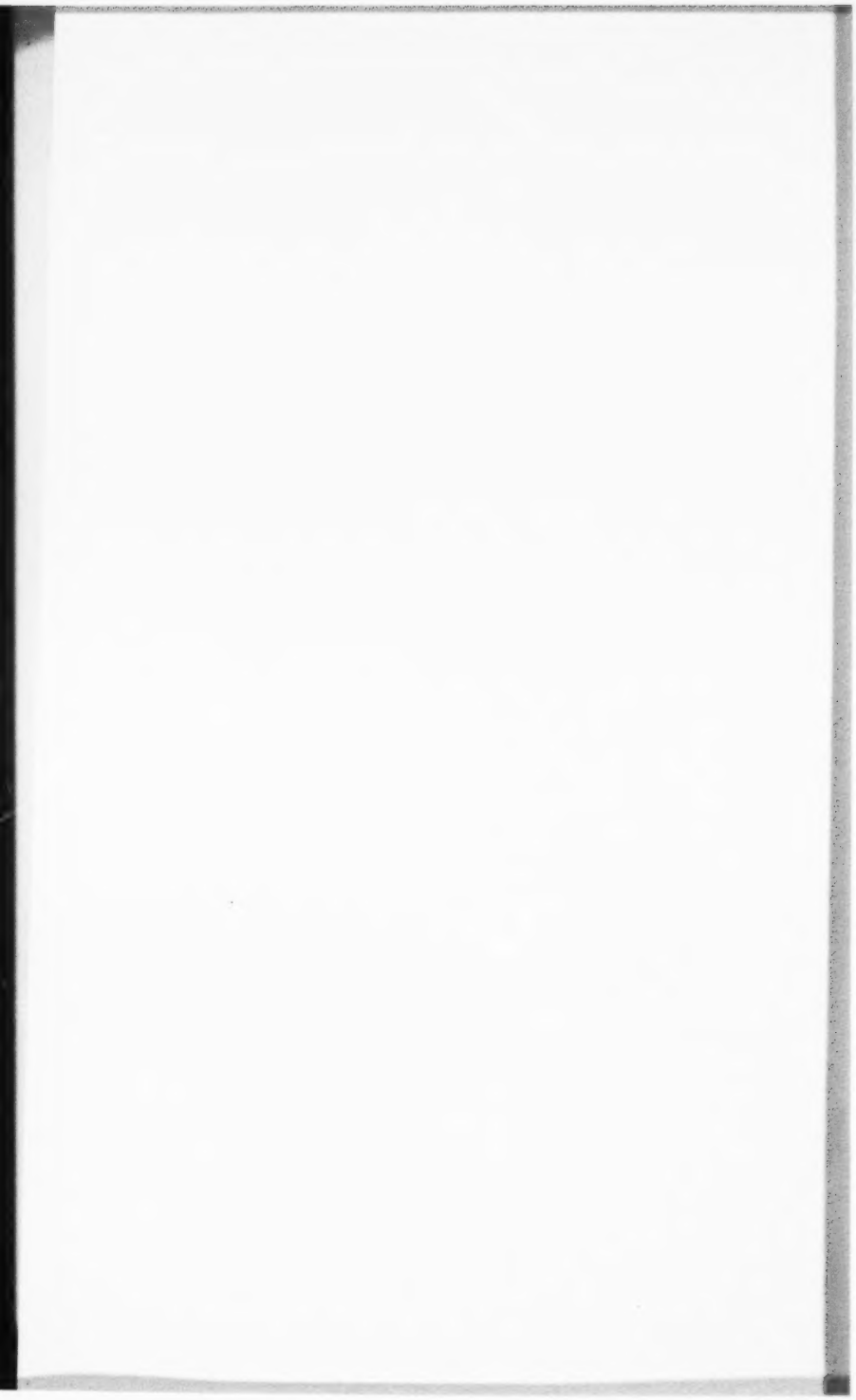
SEPTEMBER 1943.



APPENDIX

Rev. Stat. §§ 481, 483 (35 U. S. C. § 6) provides:

> *Duties of Commissioner.* The Commissioner of Patents * * * may, subject to the approval of the Secretary of Commerce, from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Rev. Stat. § 4904 (35 U. S. C. § 52), prior to its amendment by the Act of August 5, 1939, provided:

> *Interferences; determination of priority; issue of patent.* Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

As amended by the Act of August 5, 1939, c. 451, §§ 1 and 5, 53 Stat. 1212, which does not affect then pending interferences, Rev. Stat. § 4904 provides:

> *Interferences; determination of priority; issue of patent.* Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.

Rev. Stat. § 4916 (35 U. S. C. § 64) provides:

> *Reissue of defective patents; patents for separate parts.* Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. * * *

U. S. GOVERNMENT PRINTING OFFICE: 1943